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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,379	03/29/2004	Brent L. Davis	BOC9-2003-0051 (1082-21U)	2595
46322 7590 01/05/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487			EXAMINER ELAHEE, MD S	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 01/05/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,379	Applicant(s) DAVIS ET AL.	
	Examiner MD S. ELAHEE	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 05/30/2008. Claims 1, 6 and 8 are pending. Claims 2-5, 7 and 9-12 have been cancelled.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on March 23, 2004 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

3. Claim 8 is objected to because of the following informalities: regarding claim 8, the phrase "the method comprising," in line 3 should apparently be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 8 recites a computer-readable medium having stored thereon a computer program. Claim language does not comply with the requirements of MPEP 2106.01.I. The “medium” is only recited once in the invention disclosure (Preamble of Claim 8). Since “medium” is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal. Furthermore, “computer program” or “software” is merely a set of instructions. On the contrary, “memory”, “computer program” and “software” are well defined acceptable terminology in computer programming. Computer program is data structure. The claimed set of instructions is merely data structure. Data structures not claimed as embodied in computer-readable or machine-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer or machine. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Claim 8 fails to include practical application that produces either (1) tangible, concrete and useful result or (2) physical transformation. Therefore, since the claimed computer-readable medium does not comprise instructions to cause a processor to perform the sorting, presenting, accepting, incrementing and dialing functions of the claim then the Applicant has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by McAllister et al. (U.S. 6,421,672).

Regarding claims 1 and 8, with respect to Figures 2-7, McAllister teaches a caller-independent disambiguation method for use in an interactive voice response (IVR) system, the method comprising the steps of:

sorting a set of matching records according to counter values associated with corresponding ones of said records, said counter values indicating a number of times that a corresponding one of said matching records had previously been selected by other callers (col.3, lines 7-10, 47-54, col.4, lines 14-16, col.11, lines 5-20) (Note; since a particular called party being presented first based on frequency of calls made to the party (see col.4, lines 14-16), it is clear that the party in top position of list is based on a number of times the calls, which corresponds a particular matching record selected by different callers, being made to the party);

McAllister further teaches audibly presenting said sorted set in sequence through the IVR system (col.2, lines 62-65, col.3, lines 7-10, 47-54, col.4, lines 14-16, col.10, lines 22-46);

McAllister further teaches accepting a selection of a specific record in said set (col.2, lines 62-65, col.3, lines 7-10, 42-54);

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McAllister further teaches incrementing a counter associated with said selected specific record (col.11, lines 5-20);

McAllister further teaches dialing a person associated with said selected specific record, wherein said accepting step comprises the step of accepting a voice selection or a DTMF selection of a specific record in said set (col.2, lines 62-65, col.3, lines 7-10, 42-54).

Claim 6 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, McAllister teaches a disambiguation processor communicatively linked to said database and programmed to disambiguate a set of said data records by sorting said set of said data records in said set from highest counter value to lowest counter value (col.3, lines 7-10, 47-54, col.4, lines 14-47, col.11, lines 5-20); and

McAllister further teaches a speech recognition engine 16 in Fig.1 [i.e., voice markup interpreter] coupled to said disambiguation processor (Fig.1).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MD S ELAHEE/
MD SHAFIUL ALAM ELAHEE
Primary Examiner
Art Unit 2614
January 3, 2009